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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,489	03/30/2001	David R. Friedman	10519/18	6544
757	7590	10/03/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			NGUYEN, HUY THANH	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/823,489	<b>Applicant(s)</b> FRIEDMAN ET AL.	
	<b>Examiner</b> HUY T. NGUYEN	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/13/01</u> . | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. The Oath or Declaration for this application is missing. Applicant's cooperation is appreciated by submitting a copy of Oath or Declaration in response to the Office action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4-13,18-21,24-33,38-42 and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated Friedman et al (6,584,541).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 21,41 and 44 , Friedman teaches (Fig. 1 ) a method comprising :

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providing a solid-state memory (30) device comprising a three dimensional memory array of vertically stacked field programmable memory cells, the memory device further comprising an electrical connector coupled with the memory array;

(b) connecting the electrical connector of the memory device with an electrical connector of a digital media source;

(c) selecting a digital media file for storage in the memory device ;

(d) field-programming the field-programmable memory cells of the memory device with the selected digital media file; and

(e) disconnecting the memory device from the digital media source (column 5, lines 5-10, column 2, lines 45-68, column 4, lines 4-27).

Further for claims 21 and 44, Friedman teaches the memory is a write once field programmable memory cells (column 2, lines 39-64).

Regarding claims 4 and 24, Henry further teaches the invention of Claim 1, wherein the digital media source is located on an end user's premises.

Regarding claims 5 and 25, Friedman teaches the digital media source comprises a digital media playback device (10)(column 2, lines 60-68, Fig. 1)..

Regarding claims 6 and 26, Friedman further teaches the invention of Claim 1, wherein the digital media file comprises a digital media file selected from the group consisting of digital music, digital audio, digital video, at least one digital still image, a sequence of digital images, digital books, digital text, a digital map, digital data, games, software, or any combination thereof (column 3, lines 1-30)..

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Regarding claims 7 and 27, Friedman further teaches the digital media file is manually selected (column 3, lines 30-68).

Regarding claims 8 and 28, Friedman further teaches the digital media file is automatically selected (column 3, lines 30-68).

Regarding claims 9 and 29, Friedman further comprising retrieving the selected digital media file from a storage device internal to the digital media source since the media file stored in the memory of the storage device can be played from the memory .

Regarding claims 10 and 30, Friedman further teaches retrieving the selected digital media file from a storage device external to the digital media source (column 3, lines 15-20)..

Regarding claims 11 and 31, Friedman further teaches the invention of Claim 10, wherein the digital media source is coupled to the external storage device via a network. (column 3, lines 15-20).

Regarding claims 12 and 32, Friedman further teach the network comprises the Internet (column 3, lines 15-20)..

Regarding claims 13 and 33, Friedman further teaches the selected digital media file is generated by the digital media source (column 3, lines 1-45).

Regarding claim 18, Friedman further teaches the invention of Claim 1, wherein the memory cells comprise write-once memory cells (column 4, lines 25-40).

Regarding claim 19, Friedman further teaches the invention of Claim 1, wherein the memory cells comprise write-many memory cells (column 4, lines 25-40).

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Regarding claim 20, Friedman further teaches the memory cells comprise a semiconductor

Regarding claim 38, Friedman further teaches the memory array comprises a three dimensional memory array (column 2, lines 54-68, column 4, lines 24-36).

Regarding claim 39, Friedman further teaches the memory array comprises a two dimensional memory array (column 4, lines 24-29).

Regarding claim 40, Friedman further teaches the memory cells comprise a semiconductor material (column 2, lines 45-63).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1,4-13,15-21,24-33,35-42 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al in view of Johnson et al (6,034,882).

Regarding claims 1,21,41-42, and 44-45, Henry discloses a method for field-programming a solid-state memory device (Fig. 1) with a digital media file , the method comprising:

- (a) providing a solid-state memory device comprising a memory cells, the memory device further comprising an electrical connector coupled with the memory array;
- (b) connecting the electrical connector of the memory device with an electrical connector of a digital media source;
- (c) selecting a digital media file for storage in the memory device (section 0019) ;
- (d) field-programming the field-programmable memory cells of the memory device with the selected digital media file; and
- (e) disconnecting the memory device from the digital media source (section 0029).

Henry fails to teaches that the solid state memory is a three-dimensional memory array of vertically-stacked field-programmable memory cells .

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Johnson teaches a solid state memory comprising a three-dimensional memory array of vertically-stacked field-programmable memory cells for storing the data (column 1, lines 1-20, column 5, lines 20-40).

It would have been obvious to one of ordinary skill in the art to modify Henry with Johnson by using a solid state memory comprising a three-dimensional memory array of vertically-stacked field-programmable memory cells as taught by Johnson as an alternative to the solid state memory of Henry for storing the media file.

Regarding claims 4 and 24, Henry further teaches the invention of Claim 1, wherein the digital media source is located on an end user's premises.

Regarding claims 5 and 25, Henry further teaches the digital media source comprises a digital media playback device (sections 0013, 0021).

Regarding claims 6 and 26, Henry further teaches the invention of Claim 1, wherein the digital media file comprises a digital media file selected from the group consisting of digital music, digital audio, digital video, at least one digital still image, a sequence of digital images, digital books, digital text, a digital map, digital data, games, software, or any combination thereof (sections 0018, 0021).

Regarding claims 7 and 27, Henry further teaches the digital media file is manually selected (sections 0035-0036)

Regarding claims 8 and 28, Henry further teaches the digital media file is automatically selected. (sections 0035 –0036)



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Regarding claims 9 and 29, Henry further comprising retrieving the selected digital media file from a storage device internal to the digital media source since the media file stored in the memory of the storage device can be selectively retrieved by the user (sections 0008-0011).

Regarding claims 10 and 30 Henry further teaches retrieving the selected digital media file from a storage device external to the digital media source (Fig. 3, sections 0022,0032-0033,0035).

Regarding claims 11 and 31, Henry further teaches the invention of Claim 10, wherein the digital media source is coupled to the external storage device via a network. (Fig. 3, section 0032).

Regarding claims 12 and 32, Henry further teach the network comprises the Internet (Fig. 3, section 0032-033).

Regarding claims 13 and 33, Henry further teaches the selected digital media file is generated by the digital media source (sections 0022,0032-0033).

Regarding claims 15 ad 35, Henry as modified with Johnson further teaches :  
connecting the electrical connector of the memory device with an electrical connector of a digital media playback device; and

with the digital media playback device, playing the digital media file field programmed in the memory device (See Henry, sections 0008,0035, Fig. 1).

Regarding claims 16 and 36, Henry further teaches the digital media playback device comprises a device selected from the group consisting of a digital audio player, a

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digital audio book an electronic book, a digital camera, a game player, a general-purpose computer, a personal digital assistant, a portable telephone, a printer, and a projector (section 0018, 0022).

Regarding claims 17 and 37 , Henry further teaches the digital media file will only play if played from the memory device since the media file is stored in the memory device and played from the memory device.

Regarding claim 18, Henry as modified with Johnson further teaches the invention of Claim 1, wherein the memory cells comprise write-once memory cells (See Johnson column 1, lines 30-45).

Regarding claim 19, Henry as modified with Johnson further teaches the invention of Claim 1, wherein the memory cells comprise write-many memory cells See Johnson column 1, lines 30-45).

Regarding claim 20, Henry teaches the memory cells comprise a semiconductor

Regarding claim 38, Henry as modified with Johnson further the memory array comprises a three dimensional memory array (Johnson , column 5, lines 30-37).

Regarding claim 39, Henry as modified with Johnson teaches the memory array comprises a two dimensional memory array (Johnson columns 1,3).

Regarding claim 40, Henry as modified with Johnson teaches the memory cells comprise a semiconductor 30 material (Johnson column 1).

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6. Claims 2,3 ,14, 22,23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al in view of Johnson et al (6,034,882) in view of Montoya et al (5,949,688).

Regarding claims 2,3 and 22-23, Henry fails to teach that the digital media source comprises a kiosk or is located in a retail store. However, it is noted that providing a digital media source comprises a kiosk and located in a retail store is well known in the art as taught by Montoya (Figs. 1-4, column 4, lines 15-63, column 5, lines 9-20). Therefore it is obvious to one of ordinary skill in the art to modify Henry with Montoya by provide the media source at location in kiosk or retailer as an alternative to the location of the digital media source of Henry.

Regarding claims 14 and 34, Henry as modified with Montoya further teaches charging a user of the memory device for a digital media file (See Montoya column 4, lines 15-63)..

7. Claims 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al in view of Johnson et al (6,034,882) in view of Mackintosh et al (6,317,784).

Regarding claims 43 and 46, Henry as modified with Johnson fails to specifically teach the digital media file is transferred from a digital media source to the memory device via a wireless connection. However it is noted that using a wireless connection for transferring the data from a digital media source is well known in the art as taught by Mackintosh (column 5, lines 1-30). It would have been obvious to one of ordinary skill in

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the art to modify Henry with Mackintosh by provide the memory device of Henry with a wireless connection for receiving the media file thereby enhancing the capacity of the memory device of Henry for receiving the media filed from wireless connection source

8. Claims 41 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (5,966,495) in view of Leedy (5,915,167).

Regarding claims 41 and 44, Takahashi discloses a method for field-programming a solid-state, write-once memory device with a digital media file, the method comprising

- (a) providing a solid-state memory device comprising a memory array, the memory device further comprising an electrical connector coupled with the memory array;
- (b) connecting the electrical connector of the memory device with an electrical connector of a digital media source;
- (c) selecting a digital media file for storage in the memory device;
- (d) field-programming memory cells of the memory array of the memory device with the selected digital media file (column 7, line 1-30); and

Takahashi fails to specifically teach that the memory device comprising a plurality of write once cells.

Leedy (5,915,167) teaches a solid state memory of the type of field programmable memory having a plurality write once cells (column 3, lines 65 to column 4, line 18, column 15, lines 60-67).

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It would have been obvious to one of ordinary skill in the art to modify Takahashi with Leedy by using the solid state memory of Leedy as an alternative to the memory of Takahashi for storing the media files in order to improve the density of data of the media files been stored on the memory .

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 44 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,584,541.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 44 of the present application and claims 1 of U.S. Patent No. 6,584,541 is that claims 1 of U.S. Patent No. 6,584,541 further recite a rewritable memory for storing the data to be transferred to the solid state memory that is not recited in claim 44 . However it is noted that eliminating a part is obvious to a practitioner in the art See Elimination of an element and its function---*In re Karlson*, 153 USPQ 184 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1 of U.S. Patent No. 6,584,541 by eliminating the rewrite memory in claim 1 and providing the media file to the write once memory to produce claim 44 of the present application.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yap et al and Tseng et al teach a vending machine for recording media file on a medium or memory. Nii teaches a kiosk as means for distributing the media files. Namias teaches recording video at a kiosk

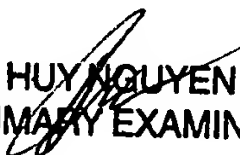
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

  
HUY NGUYEN  
PRIMARY EXAMINER